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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/987,740 12/09/97 BOYER

F UV-29

EXAMINER

TM02/0703

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VAUGHN JR, W

ART UNIT

PAPER NUMBER

2152

DATE MAILED:

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/987,740

Applicant(s)

BOYER ET AL.

Examiner

William C. Vaughn, Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1. This Action is in response to the Amendment and Reply received on 10 April 2001.

Continued Prosecution Application

2. The request filed on 10 April 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/987,740 is acceptable and a CPA has been established. An action on the CPA follows.

3. This application has been examined. **Original claims 1-60** are pending as well as newly added **claims 61-76**. The objections and rejections cited are as stated below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (Schein), U.S. Patent No. 6,002,394 in view of Payne et al. (Payne), U.S. Patent No. 6,021,433.
6. Regarding **independent claims 1 and 20**, Schein discloses the invention substantially as claimed (e.g. as in exemplary **independent claim 1**). Schein discloses an internet television program guide reminder system for providing reminders of scheduled television events to a user at a multimedia system over the Internet comprising a web server for providing web pages of

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television program listings over the Internet, wherein the web server provides the user with an opportunity to select a television program from the television program listings web pages provided over the Internet, and sends the reminder to the multimedia system over the Internet to remind the user when that television program is to be broadcast [see Schein, Col. 2, lines 20-67, Col. 9, lines 21-67, Col. 15, lines 58-67 and Col. 16, lines 1-14] . However, Schein does not explicitly disclose that the reminders of scheduled television events are done through e-mail reminders. Eventhough, Schein does discloses the utilization of email notifications as well as sending outgoing messages to other television views or users connected to the television schedule system, e.g. users on the Internet [see Schein, Figs. 19A-19C, Col. 23, lines 19-36], so it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have allowing for users of Internet television as taught by Schein to have including a system that allowed for the reminder of television events through the use of e-mail, since Schein provides for the teachings of scheduling and notifying of different television events through the internet.

7. In the same field of endeavor, Payne discloses in an analogous art (e.g. system and method for broadcast notifications to users). Payne discloses sending email reminders (Payne teaches a system in which a user may specify which types of events it would like to be notified of (i.e. sports, news) through e-mail alerts that may also be scheduled at specific times, [see Payne, Col. 19, lines 64-67, Col. 20, lines 1-13].

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8. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Payne's teachings of a system and method for broadcast notification to users with the teachings of Schein for the purpose of providing up to the minute notification information to users through the use of a web server for news, sports, financial stories, premium and special event fees (pay per view events), advertisement/promotions, graphic, sound, and scheduled updates. And since these notifications may occur the a television signal as well as a pay per view environment [see Payne, Col. 19, lines 64-67 and Col. 20, lines 1-12], the motivation to combine would have been obvious to one of ordinary skill in the networking art. By this rationale **independent claims 1 and 20**.

9. **Dependent claims 2-19 and 21-76**, recite features which are common in the networking art and are taught within the figures of Schein-Payne. Further regarding the limitations of wherein the web pages provide an e-mail reminder option which the user selects to order e-mail reminders and wherein the web server presents a how often web page when the how often option is selected wherein the web pages provide a view current reminders option which the user selects to receive a list of current e-mail reminder orders and wherein the web pages provide a new reminders option which the user selects to order an e-mail reminder message by entering a program title (It would have been obvious to one of ordinary skill in the networking art at the time the invention was made for Schein-Payne to have provided for an additional option for teaches numerous options for view current reminders, new reminders, since the programming options of scheduled events are explicitly taught in Schein-Payne [see Schein, Col. 15, lines 58-67 and Col. 16, lines 1-14].

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Claim Rejections - 35 USC § 103

10. **Claims 1-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mighdoll et al. (Mighdoll), U.S. Patent No. 6,073,168 in view of Gardell et al. (Gardell), U.S. Patent No. 6,049,831.

11. Regarding **independent claims 1 and 20**, Mighdoll discloses the invention substantially as claimed (e.g. as in exemplary **independent claim 1**). Mighdoll discloses an internet television program guide reminder system for providing reminders of scheduled television events to a user at a multimedia system over the Internet comprising a web server (5) for providing web pages of television program listings over the Internet, wherein the web server provides the user with an opportunity to select a television program from the television program listings web pages provided over the Internet [see Mighdoll, Col. 3, lines 45-56, Col. 5, lines 40-67, Col. 6, lines]. However, Mighdoll does not explicitly disclose that the reminders of scheduled television events are done through e-mail reminders.

12. In the same field of endeavor, Gardell discloses in an analogous art (e.g. accessing a network using a variety of types of apparatus, such as a set top box for a television or a computer). Gardell discloses sending email reminders (Gardell teaches a email box that has user preferences that allow for a user to receive such services as broadcast television and that the web

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server would transfer email notification to STB via a browser and that the notification messages may then be played on top of a current broadcast program, [see Gardell, Col. 8, lines 23-39].

13. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Gardell's teachings of accessing a network using a variety of types of apparatus, such as a set top box for a television or a computer with the teachings of Mighdoll for the purpose of allowing a user to access information through a STB which would allow for a more flexible means of accessing information [see Gardell, Col. 1, lines 55-57]. By this rationale **independent claims 1 and 20**.

Response to Arguments

14.. Applicant's Request for Reconsideration filed on 11 April 2001 has been carefully considered but is are not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

15. Applicant states that the cited sections of Schein-Payne fail to show or suggest the invention as defined in claims 1 and 20. Specifically Applicant states that "Schein provides a description of a television program guide that has a reminder feature, the description does not go beyond mentioning that "programs can be selected for . . . placing a reminder to watch the program", thereby providing n indication that the reminder is sent via e-mail. Applicant also asserts that the passages of Schein provide no indication as to whether the e-mail messages are

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reminders for scheduled television events that have been selected by a user from a set of television listings. It would have been obvious to one of ordinary skill in the art at the time the invention was made for Schein to have recognized that the ability to send email reminders that remind users or anyone that a program is schedule is notoriously well known. It is obvious that the technological capability to send reminders that include specific references to what a users would like to be reminded of could and is being done within Schein-Payne. Applicant has not provided in any way the necessary claim languages that separates their claimed invention from other prior art records that have been disclosed by the Examiner. Since Shein does teach a reminder feature within the invention as well as an email feature. One could obviously utilize the email system within Schein to also take the reminder information for a particular program listing to remind them of a featured event. Also Schein-Payne teaches data feeds include but are not limited to, email and other personal alert notification, news, sports, and financial stories [see Payne, Col. 7, lines 50-54 and Col. 29, lines 65-67, Col. 30, lines 1-67, Col. 31, lines 1-67]. Schein-Payne also teach what type of information should be sent and when it should been sent to different subscribers. Again, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have known that the type of information included in the notification or alerts (reminders) could essentially be reminders of specific types of scheduled television programs or listings. And it also of unclear to the metes and bounds of the claim subject matter as it is presently claimed. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).< See *>also< In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

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("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

16. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations which define the operation and apparatus of Applicant's disclosed invention in manner which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Schein-Payne and other prior arts of records disclosed, for user's in a internet television programming environment to be reminder through the use of e-mail of specific televised programs through the internet as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on Monday through Friday from 8:00 to 4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for this Group is (703) 305-9731 or (703) 305-9731 (for informal or draft communications, please label "**PROPOSED**" or "**DRAFT**"). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, DC 20231

OR:

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Driver, Arlington, VA., Sixth Floor (Receptionist)

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Patent Examiner
AU 2152
June 30, 2001

[Signature]
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